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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/479,267 01/06/00 UENO

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EXAMINER

WM01/0608

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ART UNIT

PAPER NUMBER

2652

DATE MAILED:

06/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/479,267

Applicant(s)

UENO ET AL.

Examiner

Franklin D. Altman

Art Unit

2652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

Art Unit: 2652

**DETAILED ACTION**

***Response to Amendment***

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Aoshima et al (U.S. Patent 6,046,892).

As per claim 1:

Aoshima et al disclose a spin valve magnetoresistance sensor {20}, including a base layer {21,22} on top of a substrate {inherent from “substrate”, column 1, line 36}, the base layer including a first base film {21} and a second base film {22} formed on top of the first base film {21}, the second base film {22} having an alloy (“NiFeCr” in Figure 5) represented by NiFeX wherein X includes one of Cr, Nb and Rh, the second base film having a face-centered cubic (fcc) structure and a (111) orientation {inherent from “NiFeCr<sub>24.3%</sub>(3)” in Figure 5}.

To better understand the inherent structure disclosed by Aoshima et al and for definitional purposes only, it is noted that Iwasaki et al (U.S. Patent 6,157,525) discloses that NiFeCr has an fcc structure and 111 orientation (column 8, lines 32-36, Iwasaki et al)

Art Unit: 2652

As per claim 2:

Aoshima et al disclose wherein a film thickness {"3 nm", column 3, line 38} of the second base film {22} is within a range of 20 to 100Å. {It is noted the 3 nm is identical to 30 Å, which is within the claimed range.}

As per claim 3:

Aoshima et al disclose the second base film (22) within the range of 20 to 50 at%. See Figure 5.

As per claim 4:

Aoshima et al disclose wherein the spin valve magnetoresistance sensor is located within a thin film magnetic head {Figure 4}.

***Response to Arguments***

Applicant's arguments filed 5/18/2001 have been fully considered but they are not persuasive. Applicant asserts the presence of unclaimed extra structure, Aoshima's layer 23 having an face-centered cubic structure.

"To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently." In re Schreiber , 128 F.3d at 1477. Anticipation of a patent claim requires a finding that the claim at issue "reads on" a prior art reference. See Titanium Metals Corp. v. Banner , 778 F.2d 775, 781, 227 USPQ 773, 778 (Fed. Cir. 1985). In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then **that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.** See id. at 781. (Emphasis Added)

Applicant further asserts that Aoshima et al's, identical second base film, NiFeCr, with Cr at 24.3 atomic percent lacks the basic chemical lattice structure of a face-centered cubic (fcc)

Art Unit: 2652

structure at 111 orientation. For definitional purposes only, Iwasaki et al is cited for teaching these basic properties (fcc structure, at 111 orientation) of NiFeCr film at low atomic percentage Cr.

“The identity required for anticipation is between the claimed subject matter and the subject matter disclosed by the reference; identity does not require the reference to disclose the same subject matter as described in the specification.”, Kalman v. Kimberly Clark Corp., 218 USPQ 781 (Fed. Cir. 1983)

“The disclosure in a reference must show the claimed elements arranged as in the claim but need not be in the identical words as used in the claims to be anticipatory.” In re Bond, 15 USPQ2d 1566 (Fed. Cir. 1990)

“The discovery of a new use for a prior art structure based on previously unknown properties of the structure may be patentable as a method, but is **anticipated, under the principles of inherency**, if the structure necessarily functions in accordance with the limitations of the claimed method.” In re King, 231 USPQ 136 (Fed Cir. 1986). (emphasis added)

“A publication need not identify a utility for its disclosure of a claimed compound to be an anticipatory reference.” In re Schoewald, 22 USPQ 1671 (Fed. Cir. 1992)

“Anticipation is a question of fact and a PTO holding of anticipation will not be reversed by a court unless the court finds the holding to be clearly erroneous.” In Re Baxter Travenol Labs., 21USPQ2d 1281 (Fed. Cir. 1991)

“Anticipation must be based on a single reference, device or process.” Studiengesellschaft Kohle v. Dart Ind., Inc., 220 USPQ 841 (Fed. Cir. 1984). “However, extrinsic evidence may be used to explain, but not to expand, the meaning of a reference.” In re Baxter Travenol Labs., supra. “Where the claimed invention is a chemical compound which is disclosed in a reference, an additional reference may be cited to show that PHOSITA could have made the compound.” In re Donohue, 226 USPQ 619 (Fed. Cir. 1985).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Franklin D. Altman whose telephone number is (703) 305-7494. The examiner can normally be reached on m-th, 6:30 am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Nguyen, can be reached at (703) 305-9687.


The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-9021 for formal communications or (703) 308-90511 for informal communications, which should be so designated.

Art Unit: 2652

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.



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